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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,852	08/07/2004	Scott Dresden	X-9277	7986
24131	7590	01/06/2010	EXAMINER	
LERNER GREENBERG STEMER LLP			AHMED, AFFAF	
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HOLLYWOOD, FL 33022-2480			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/710,852	DRESDEN, SCOTT	
	<b>Examiner</b>	<b>Art Unit</b>	
	AFAF AHMED	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 December 2009.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 26 and 30-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 26 and 30-35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 07 August 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Status of Claims***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17 (e), was filed in this application after final rejection. since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17 (e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/07/2009 has been entered.
2. Claims 26, 32-33 and 35 have been amended.
3. Claims 27-29 have been canceled.
4. Claims 26, 30-35 are currently pending and have been examined.

### ***Response to Applicant's Arguments***

5. Applicant's amendments and arguments filed on 12/07/2009 have been fully considered and discussed in the next section. Applicant is reminded that the claims must be given its broadest, reasonable interpretation.
6. With regard to claim 26 rejection under 35 USC § 101, Applicant's arguments are considered, but they are not persuasive. Applicant's amendment fails to tie the claimed invention to (1) a particular machine or apparatus (2) transform a particular article into a different state or thing. Applicant argues that "*placing the call and routing the call to the selected vendor is not insignificant extra solution activity, but rather is integral to practicing the invention. In fact even the preamble specifies that the invention relates to routing a telephone call*". However, placing the call and routing the call to the selected vendor is not clearly tied to a machine and/or performed by a computer as Applicant asserted. Furthermore, the recitation of routing a telephone call has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, the rejection of independent claim 26 and its dependent claims under 35 USC § 101 is maintained.

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7. With regard to claim 33 rejection under 35 USC § 112 first paragraph, Applicant's arguments are considered are persuasive. Therefore, claim 33 rejection under 35 USC § 112 first paragraph is withdrawn.

8. With regard to claim 26 rejection under 35 USC § 102 (b), Applicant's arguments are considered, but they are moot based on the new ground of rejection.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

11. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 26, 30-35 provisionally rejected on the ground of nonstatutory double patenting over claims 17-19 of copending Application No. 11/164084. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. Claim 17 of the co-pending application recites the limitation of: *accessing performance data, said performance data related to said at least one search engine; determining the relative cost of said advertising channel for at least one product; and providing a price target for acquisition of said advertisement*. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the instant application accessing performance data, said performance data related to said at least one search engine and determining the relative cost of said advertising channel for at least one product; and providing a

price target for acquisition of said advertisement with the motivation of correctly billing advertisers based on paid –placement performance.

- Claims 26, 30-35 provisionally rejected on the ground of nonstatutory double patenting over claims 1-11 of copending Application No. 11/877639. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variation of each other. Claims 1 and 10 of the co-pending application recite the limitations of: *wherein said customer makes said customer call by dialing said phone and entering one of said plurality of consumer category codes, determining which of said plurality of consumer category codes is entered by said customer; associating said customer call with a consumer category based on which of said plurality of consumer category codes is entered and creating a consumer category database, wherein said consumer category database contains at least one vendor related with said consumer category.* It would have been obvious to one of ordinary skill in the art at the time of the invention to include *entering one of said plurality of consumer category codes, determining which of said plurality of consumer category codes is entered by said customer; associating said customer call with a consumer category based on which of said plurality of consumer category codes is entered and creating a consumer category database, wherein said consumer category database contains at least one vendor related with said consumer category* with the motivation of keeping track of particular category and/or particular advertisement effectiveness.

13. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: advertising of a telephonic number for a product or service to be sold, where the advertisement includes an identifier for tracking performance of the advertisement.

14. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

15. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Drawings***

16. Submitted drawing of Figures 1 and 2 are objected to, because figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP

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§ 608.02(g). as per Applicant's specification "In particular, Dr. Hall discusses the various Internet auction systems, which are depicted in a simplified form in FIGS. 1 and 2 (paragraph 5)". Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claims 26, 30,33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton, US Pat No: 6,097,792 in view of Moore, US Pat No: 7,200,566 B1.

#### **Claims 26 and 33:**

Thornton discloses:

- *placing an advertisement for a product or service on an advertisement medium , the advertisement including a telephonic number for contacting a vendor in order to obtain the product or service ( see at least column 8, lines 46-49);*
- *enabling a potential customer to place a telephone call by entering the telephonic number into a telecommunications network (see at least column 7, lines 1-10, column 8, lines 36-52 and Fig 4 with the associated text);*

- *obtaining the identification code from the telecommunications network and using the identification code to update a database, which is accessible by the particular one of the plurality of vendors, in order to obtain performance information indicating the effectiveness of the advertisement* (see at least column 10, lines 1-16, column 11, lines 14-42 and column 17, lines 19-29);

Thornton does not specifically disclose, but Moore however discloses:

- *based at least partly on bids made for routing the telephone call, selecting a particular one of the plurality of vendors and routing the telephone call through the telecommunications network to the particular one of the plurality of vendors* (see at least column 9, lines 65-67 and column 10, lines 1-12);
- *performing the step of selecting the particular one of the plurality of vendors based at least in part on a financial range provided by the potential customer* (see at least column 9, lines 32-67 and column 10, lines 1-12) ;

It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the telephonic interactive leads system and method of Thornton the ability to allow bids made for routing the telephone call through the telecommunications network to the particular one of the plurality of vendors and selecting a particular one of the plurality of vendors as taught by Moore, since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results (providing vendors with bargaining opportunity to meet consumers' needs) of the combination were predictable.

**Claim 30:**

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

*wherein the potential customer places the telephone call by entering the telephonic number into a keypad of a telephone communicating with the telecommunications network; and the potential customer enters the identification code into the telecommunications network by entering the identification code into the keypad of the telephone communicating with the telecommunications network* (see at least column 8, lines 53-67 and column 9, lines 1-4);

**Claim 34:**

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

- *wherein the identification code is a consumer category code associated with the plurality of vendors* (see at least column 8, lines 24-64, fig 3 and fig 4 with the associated text);

**Claim 35:**

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

- *performing the step of selecting the particular one of a plurality of vendors and routing the telephone call to the particular one of the plurality of vendors based on the identification code that is included in the advertisement* (see at least column 8, lines 24-35 and fig 3 with the associated text);

19. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thornton, US Pat No: 6,097,792 in view of Moore, US Pat No: 7,200,566 B1 in view of Val et al, US Pat No: 6,898,571.

**Claims 31 and 32:**

The combination of Thornton/Moore discloses the limitations as shown above.

Thornton further discloses:

- *associating the identification code with a plurality of vendors* (see at least column 8, lines 24-64, fig 3 and fig 4 with the associated text);
- *performing the step of selecting the particular one of the plurality of vendors and routing the call to the particular one of the vendors using the identification code* (see at least column 8, lines 56-65);

The combination of Thornton/Val disclose:

- *using the identification code to identify a geographic location;*

Thornton in at least column 8, lines 53-64 discloses an embodiment, where the ID extension numbers could be used to identify particular categories of home and cars, for example, (grouped by price range of particular characteristics rather than identifying a single home or car. Thornton also in at least column 15, lines 9-41 discloses call redirection that utilizes the call routing database and can be utilized in many ways. For example, it could be used to reroute the phone call to the sponsor of the DNI, particular brokers or agents, car dealerships, or to the branch of real estate office closest to the caller's home utilizing the already captured ANI and reverse match address information.

Val in at least column 1, lines 39-42 discloses an embodiment where an advertiser advertises a product or service in the usual manner except that alpha numeric code is identified in the advertisement. The consumer, desiring additional information regarding the advertisement, uses the Internet to log onto a particular website common to all advertisers and then enters the code for the ad. The particular code then accesses an enhanced ad that specifically directed to a particular geographic location or otherwise customized for the particular customer. Val also in at least column 2, lines 48-58 discloses the advertiser prepares a set of one or more enhancement for each product. The enhancement shows the appropriate information for a given product (s). The enhancement target different regions and consumers preferences. For example the geographic regions may be divided into countries, states or regions so as to provide consumers the information consumer needs to purchase a product.

It would have been obvious to none of ordinary skill in the art at the time of the invention to include interactive method and system for the generation of leads of Thornton/ Moore the ability in the advertisement code to identify a geographic limit as taught by Val, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results (providing consumers with the appropriate services ) of the combination were predictable.

### ***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Yehdega Retta/  
Primary Examiner, Art Unit 3622